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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/474,783

Filing Date: December 30, 1999

Appellant(s): NEWELL ET AL.

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JOHN F. KACVINSKY  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 05/05/08 appealing from the Office action  
mailed 07/18/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

5,987,518	GOTWALD	11-1999
5,619,247	RUSSO	4-1997
4,945,563	HORTON ET AL.	7-1990

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-7 and 12-25, rejected under 35 U.S.C. 103(a) as being unpatentable over **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247)**.

With respect to Claims 1 and 4-6, **Gotwald** teaches a system for controlling use of broadcast content (BC) comprising:

A receiver (Client 18) in communications with a source of broadcast content (Server 12, ) and a playback device and a storage device, the receiver comprising a data interface having an Internet Protocol (IP) data module to process a pay-per-use IP TV broadcast stream comprising IP encapsulated data, the receiver to control the use of received broadcast content (BC) through the playback device and the storage device in accordance with a descriptor embedded in the received BC (col.3, line 26-col.4, line 32 and line 55-col.5, line 41), note that Server 12 (a broadcast server) receives as input Internet Protocol (IP) data (in first data protocol) and MPEG2 streams (second data

protocol), where Server 12 encapsulates the IP data into the MPEG stream (col.3, lines 33-50 and col.4, lines 8-54), encrypts the broadcast stream (col.4, lines 49-52), to produces a broadcast stream (new stream of IP/MPEG2 data packets), multiplexes the broadcast stream for communication (broadcast, multicast, etc.,) over an appropriate communication medium to receiving units (Client 18, a PC or PC/TV, col.3, lines 51-65);

Gotwald permits the Client to purchase various services and provides security to data by encrypting the data, but silent to a descriptor to indicate whether the storage device may store the received BC prior to viewing and without reproducing the received BC, storing the broadcast content and a number of times the playback device may reproduce the received broadcast content.

However, **Horton** teaches broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify Gotwald with the ability to specify the action as storing the content and embedding descriptor information in order for the broadcast provider to specify what could be done to the broadcast programs to prevent unauthorized copying and also allow the user to only access certain programs.

Gotwald as modified by Horton, fails to explicitly teach controlling the number of times that the BC may reproduce the stored BC, maintaining information relating to the use or duration of use of the received BC through the playback device for remuneration of a provider of the BC.

However, **Russo** further teaches a descriptor or supplemental information with the BC, where a receiver-controller, manages playbacks of stored BC, including duration (time, days, week, etc.,) of use, monitors various user activities as to the use of the BC, controlling billing and payment for remuneration of a provider of the BC (col.4 line 45-col.5 line 47, col.6 lines 34-55, col.8 lines 65-67 and col.9 line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to incorporate the teaching of Russo into the system of Gotwald as modified by Horton to manage the reproduction of the stored BC for fees and royalties to the service provider and furthermore, permit only authorized user, based on credit or payment history, to reproduce and view the stored BC any number of times as desire.

Further, a *prima facie* case of obvious is made because all of the elements are known (as shown in the prior art), and could be combined by known methods of encapsulating data into an IP data word. This would result in the predicted results of allowing a user the ability to watch content a given number of times. Or be allowed to view content that they have the right to see.

As to claim 7, the claimed “method comprising...” is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

Claims 12-15 are met as previously discussed with respect to claims 1 and 4-6.

As to claims 16-18, Gotwald further discloses obtaining payment information from the user of the received broadcast content, communicating consumption information to a billing facility at the service provider of the BC (col.4, line 49-col.5, line 6).

As to claim 19, the claimed “a machine-readable medium... a method comprising...” is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

As to claim 20, Gotwald further discloses where the storage comprises a memory accessible by a computer (col.3, line 51-col.4, line 7).

As to claim 21, Gotwald as modified by Horton and Russo, fail to show that the storage medium comprises a portable storage device. However, Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMS or removable hard drives.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify the system of Gotwald as modified by Horton and Russo with a portable storage device so that the instructions could be transported to other systems.

As to claims 22-25, the claimed “A system comprising a receiver in communication with a source of broadcast content...” is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

## **(10) Response to Argument**

With respect to claims 1, 4-7, 9 and 12-25 rejected under 35 U.S.C. 103(a) as being unpatentable over **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247)**, the Examiner disagrees that the rejection should be reversed. Appellant argues that “Gotwald, Horton et al., and Russo, whether taken alone or in combination, are insufficient to establish a *prima facie* case of

obviousness...", etc., and further cites portions of MPEP as to obviousness and states three basic criteria to establish a *prima facie* case of obviousness (see page 11+ of Appellant's Brief).

Appellant's traversal of the combination of the plurality of references stem primarily from Appellant's mischaracterization of the Gotwald reference, where Appellant states (see page 11+ of Appellant's Brief) that "...that Gotwald, Horton et al., and Russo, whether taken alone or in combination, are insufficient to establish a *prima facie* case of obviousness with respect to the amended claims..." that "...claim 1 recites 'pay-per-use Internet Protocol (IP) television broadcast stream'..." that "...cited portion of Gotwald arguably discloses the encapsulation of IP data within a standard MPEG2 video stream...that video stream is a standard MPEG2 video stream and is not an IP stream...Gotwald arguably allows traditional IP data to be sent within a MPEG2 video stream..." First Examiner respectfully disagrees that the rejection is not proper. Gotwald meets the claim limitation "pay-per-use Internet Protocol (IP) television broadcast stream" Gotwald teaches encapsulating Internet Protocol (IP) data in a broadcast stream; as illustrated in figures 1-3, the Server 12 (a broadcast server) receives as input Internet Protocol (IP) data (in first data protocol) and MPEG2 stream (second data protocol), where Server 12 encapsulates the IP data into the MPEG stream (col.3, lines 33-50 and col.4, lines 8-54), encrypts the broadcast stream (col.4, lines 49-52), to produces a broadcast stream (new stream of IP/MPEG2 data packets), multiplexes the broadcast stream for communication (broadcast, multicast, etc.,) over an appropriate communication medium to receiving units (Client 18, a PC or PC/TV, col.3, lines 51-65),

Client(s) 18, which includes a data interface. Client 18, receives the broadcast stream demodulates and decrypts (if client meets purchasing criteria) the broadcast stream where the client processor, processes the received broadcast stream packets accordingly to permit Client 18 to playback or view the received content (col.4, line 55-col.5, line 45 and col.6, lines 40-50). Hence Gotwald clearly meets the claim limitation, "Internet Protocol (IP) television broadcast stream" and further teaches providing security to the data, by encrypting/decrypting data and permits the Client to purchase various services.

Appellant further argues (see page 12+ of Appellant's Brief) that "...Gotwald, Horton and Russo fail to teach, suggest or disclose indicating 'a number of times the playback device may reproduce the received broadcast content' as recited in...claim 1...Office Action, this limitation is disclosed by Russo...Appellant respectfully disagrees..." citing various portions of Russo. First as note in the office action above, Gotwald is silent as to the number of times the playback device may reproduce the received broadcast content. However, in the same field of endeavor, **Russo** stores pay-per-view (PPV) programs or movies and controls or restricts the number of times the stored program(s) is playback, by setting a duration (time, days, week, etc.,) of use, monitors various user activities as to the use of the broadcast content, controlling billing and payment for remuneration of a provider of the broadcast content (col.4 line 45-col.5 line 47, col.6 lines 34-55, col.8 lines 65-67 and col.9 line 1+). By providing a predetermined duration of playing back stored programs or movies (with fixed duration

or playing time), Russo clearly teaches restricting a number of times the playback device may reproduce (view) the received broadcast content.

Appellant further argues (see page 13+ of Appellant's Brief) that "...the cited reference...fail to teach or disclose 'a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content.'..." In response to Appellant's arguments, Gotwald is silent as to this limitation, however, in the same field of endeavor **Horton** discloses broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67). Horton teaches that the code information (descriptor) embedded in the TV signal provides various modes, i.e., view only, video and tape for a fee, view and tape for free, etc., available to the program and routes the video program either to user's monitor or VCR as desired.

As to Appellant's arguments (see page 11+ of Appellant Brief) that, is not obvious to combine the prior arts of record, Examiner disagrees. As discussed above, Gotwald meets most of the claimed limitation, i.e. broadcast content comprising IP encapsulated data, providing security by encrypting/decrypting data and permitting customers to purchase services before reproducing the content. Clearly Gotwald controls reproduction of data at the Client, but silent as to controlling the number of times to reproduce the data and the claimed "a descriptor" However this deficiencies are disclosed in the prior arts of Russo and Horton. In any event, the Appellant is reminded

that a reference can be relied upon for all that would have been reasonably suggested to one or ordinary skill in the art, including non-preferred embodiments. See MPEP 2123. Hence, while Gotwald teaches preferred or alternate embodiments, Gotwald system teaches all the steps of receiving two or more protocol data, processing the data to produce a broadcast stream (IP/MPEG2 data packets), encrypts the packets, and multiplexes for distribution to Clients over a communication medium. The only teaching absent from Gotwald is controlling the number of times the content may be reproduced and code information to indicate various modes for reproducing of the content, for which Russo and Horton has been relied upon. Further, a *prima facie* case of obvious is made because all of the elements are known (as shown in the prior art), and could be combined by known methods of encapsulating IP into a broadcast stream to form an IP data packet. This would result in the predicted results of allowing a user the ability to watch content a given number of times. Hence, the 103(a) rejection, of claims 1, 4-7 and 12-25, is proper, meets all the claims limitations and should be sustained.

**(11) Related Proceeding(s) Appendix**

None

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Annan Q Shang/

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